

REMARKS

Applicants respectfully acknowledge receipt of the Final Office Action mailed July 6, 2006.

In the Final Office Action, the Examiner rejected claims 1, 15, 16, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over *Suzuki et al.* (U.S. Patent Pub. No. 2003/0168796) in view of *Lamothe* (U.S. Patent Pub. No. 2003/0116599); and rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over *Suzuki* in view of *Lamothe*, and further in view of *Kato et al.* (Japanese Patent No. 2002003069).

By this Amendment After Final, Applicants propose to amend claims 1 and 15-19 to improve form, correct informalities, and better define the claimed invention. Upon entry of this proposed Amendment, claims 1, 2, 4-24, and 30 will remain pending, with claims 2, 4-14, 20-24, and 30 withdrawn from consideration. Claims 3 and 25-29 were previously canceled, without prejudice or disclaimer, in the Reply to Office Action filed April 25, 2006. In accordance with 37 C.F.R. § 1.141, the Examiner is respectfully reminded that upon the allowance of generic claim 1, Applicants are entitled to the consideration of the claims to additional species which are written in dependent form or otherwise include all the limitations of the allowed generic claim.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 1 and 15-19. No new matter has been introduced.

Applicants traverse the rejections above and respectfully request reconsideration for at least the reasons that follow.

I. 35 U.S.C. § 103(a) REJECTIONS

Claims 1, 15, 16, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Suzuki* in view of *Lamothe*. Applicants respectfully disagree with the Examiner's arguments and conclusions and submit that independent claim 1 is patentably distinguishable over *Suzuki* and *Lamothe* at least for the reasons set forth below.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on applicant's disclosure." See M.P.E.P. §2143, 8th ed., February 2003.

Suzuki discloses a sheet processing apparatus including an image forming portion 1, a plurality of sheet conveying units 10A - 10E, offset stackers 11a and 11b, staple stackers 20a and 20b, and a center bookbinding machine 33 which includes a stapler 34 for stapling a sheet bundle and a folding apparatus 35 for folding a central portion of the sheet bundle (emphases added). (*Suzuki*, [0030]-[0036], [0055], and [0080]).

However, as admitted by the Examiner, *Suzuki*, at least, "does not disclose a puncher, a perforator, and a cutter." (*Office Action*, p. 2, paragraph 3, ll. 12-13).

Additionally, *Suzuki* fails to teach or suggest wherein the at least two or more types of units in the single-sheet processing machine punch, fold, perforate, and cut sections of a single cut sheet (emphases added). Furthermore, the Examiner relies on the center bookbinding machine 33 in FIG. 8 for having several postprocessing functions, such as stapling, folding, etc., and analogizes the machine 33 to the claimed single-sheet processing machine. Based on this premise, however, *Suzuki* fails to disclose a postprocessing machine arranged at a downstream position with respect to the single-sheet processing machine in a sheet conveying direction.

To cure the deficiencies of *Suzuki*, the Examiner relies on *Lamothe* for an alleged disclosure of “a puncher for the purpose of punching holes in a sheet; a perforator for the purpose of perforating a sheet; and a cutter for the purpose of cutting a sheet.” (*Id.* at p. 2, paragraph 3, ll. 13-15).

Lamothe discloses a configurable paper transport including a frame 12 having a plurality of rollers 14, a paper web 20, and a plurality of stations 26, wherein each station 26 removably secures a single non-driven paper device 28, such as a perforator, a hole puncher, a die cutter, a printer, etc. (emphases added). (*Lamothe*, [0018], [0020]-[0021]). For example, each station 26 can only provide a single postprocessing function, such as perforating, hole punching, or cutting (emphases added).

Lamothe, however, fails to disclose at least two or more types of postprocessing units, each performing at least two or more postprocessing functions, such as perforating, hole punching, or cutting, within a single single-sheet processing machine (emphases added).

Even if the non-driven paper device 28 of *Lamothe* properly could be considered a unit in the claimed invention, which Applicants do not necessarily concede, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine *Suzuki* and *Lamothe* in a manner resulting in the claimed invention. Furthermore, there is no reasonable expectation of success. Rather, the Examiner has used impermissible hindsight as a motivation to combine *Suzuki* and *Lamothe*. “Knowledge of applicant’s disclosure must be put aside in reaching [the] determination” of the level of ordinary skill in the art. M.P.E.P. § 2142, 8th Ed., Rev. 3 (August 2005), p. 2100-134. Thus, “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art” (emphasis added). *Id.*

Accordingly, with respect to independent claim 1, *Suzuki* and *Lamothe* fail to teach or suggest the claimed combination, including, *inter alia*:

“a single-sheet processing machine...attached to a postprocessing machine arranged at a downstream position with respect to the single-sheet processing machine, [and having] at least two or more types of postprocessing units, the units including a punching unit for punching sections of [a] cut sheet, a folding unit for folding sections of the cut sheet, a perforator for perforating sections of the cut sheet, and a cutter for cutting sections of the cut sheet...”

The Examiner has therefore not met at least one of the essential criteria for establishing a *prima facie* case of obviousness, wherein “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See M.P.E.P. §§ 2142, 2143, and 2143.03. Accordingly, independent claim 1 is patentable over *Suzuki* and *Lamothe*. Applicants therefore request that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn and claim 1 be allowed.

Moreover, claims 15, 16, 18, and 19 are in condition for allowance at least due to their dependence from independent claim 1. In addition, the dependent claims may recite unique combinations that are neither disclosed nor suggested by the cited art, and therefore are separately patentable.

Applicants respectfully traverse the Examiner's rejection of claim 17 under 35 U.S.C. § 103(a) as being unpatentable over *Suzuki* in view of the *Lamothe*, and further in view of *Kato*. The shortcomings of *Suzuki* and *Lamothe* are discussed above.

With respect to *Kato*, the Examiner alleges that "Kato discloses...a trimmer (C) for trimming a folded sheet bulk for the purpose of making [an] unfolded edge of the sheets of the folded sheet bulk flush and aligned." (*Office Action*, p. 3, paragraph 4, ll. 5-6). Such teachings, even if present in *Kato*, however, fail to teach or suggest "a single-sheet processing machine...[having] at least two or more types of postprocessing units, the units including a punching unit for punching sections of [a] cut sheet, a folding unit for folding sections of the cut sheet, a perforator for perforating sections of the cut sheet, and a cutter for cutting sections of the cut sheet...", as required by Applicants' claim 1. Thus, *Kato* also fails to overcome the above noted shortcomings of *Suzuki* and *Lamothe*, and claim 17 is allowable at least due to its dependence from independent claim 1.

II. CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1 and 15-19 in condition for allowance. Applicants submit that the proposed amendments of claims 1 and 15-19 do not raise new issues or necessitate the undertaking of any additional search of the art by the

Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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